

REMARKS

This Reply is in response to the Final Office Action mailed on March 8, 2007 in which claims 1-36 and 38-41 were rejected. With this response, claim 42 is added. Claims 1-36 and 38-42 are presented for reconsideration and allowance.

I. Request for Withdrawal of the Final Office Action Mailed on September 12, 2007

Applicants respectfully request that the Final Office Action be withdrawn since the Final Office Action rejects claim 41, which corresponds to former objected to claim 17, based upon a new ground of rejection NOT necessitated by Applicants' amendment.

MPEP 706.07(a) states:

a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art ... of any claim not amended by applicants or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

In the Office Action mailed on March 8, 2007, the Examiner indicated that claim 17 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, claim 17 was rewritten in independent form as added claim 41 and incorporated all of the limitations of former base claim 17.

Now, the Final Office Action rejects claim 41 based upon Jill and Bob. However, since claim 41 corresponds to former objected to claim 17, this rejection of claim 41 constitutes a new ground rejection. This new ground rejection was not based upon any amendments by Applicants. Accordingly, the finality of the Office Action mailed on September 12, 2007 is improper. The Office Action mailed on September 12, 2007 should be withdrawn. As noted in the MPEP, the previous Final Action should be withdrawn and a new non-final Office Action including consideration of the present amendments should be issued.

II. Rejection of Claims 1, 2, 5-10, 14-16, 18, 20-28, 30 31 and 40 under 35 USC 102(b) Based upon Jill and Bartok

Section 4 of the Office Action rejected claims 1, 2, 5-10, 14-16, 18, 20-28, 30 31 and 40 under 35 USC 103(a) as being unpatentable over Jill US Patent 6,774,509 in view of Bartok US Patent 6,459,060. For the reasons which follow, rejection of such claims should be withdrawn..

A. Claim 1

Claim 1 recites an electronic device which includes a switch actuation mechanism configured to actuate against a point of contact of a switch a first time in response to a first manual input to actuate the device to a first state and to actuate against the same point of contact of the switch a second time in response to a second manual input to actuate the device to a second state. The second input has a least one characteristic, other than time at which it is performed, distinct from the first input.

Neither Jill nor Bartok, alone or in combination, disclose or suggest a switch actuation mechanism that actuates against the same point of contact of a switch in response to first and second distinct manual inputs to actuate a device between first and second states. As acknowledged by the Office Action, Ryan does not disclose to input having a characteristic, other than the time at which they are performed, distinct from one another. As a result, the Office Action attempts to additionally rely upon Bob by attempting to mishmash the completely distinct teachings of Jill and Bob together in an attempt to read the hypothetical combination upon the claims. In particular, the Office Action asserts that:

It would have been obvious to one of ordinary skill in the art, at the time of the invention, two views a single point of contact with a two-surface which face like that of Bob, because a single-point-of-contact instruction is simpler than a two-point-of-contact construction.

(Final Office Action dated September 12, 2007, page 4).

However, the alleged hypothetical combination of Jill and Bob lacks merit because: (1) the alleged motivation lacks merit and (2) the hypothetical combination would destroy the intended function and principle of operation of each of the combined references.

(1) The alleged motivation lacks merit.

The assertion that it would be obvious to use a single point of contact (Jill) with a two surface switch face (Bob) lacks credulity. Although it may be true that a single point of contact instruction is simpler than a two point of contact instruction, this ignores the basic fact that a single point of contact construction only requires a single switch face while a two point of contact switch requires a two surface switch face. It would make little sense to one of ordinary skill in the art, absent Applicant's own disclosure, to combine a two surface switch face used for a two point of contact switch on a single point of contact switch. Bob requires a two surface switch face because Bob requires pivoting of face (108), Jill does not. Applying a rationale analogous to the rationale asserted by the Examiner, one of ordinary skill in the art would alternatively use a single surface switch face in Jill rather than a two surface switch face because (1) a two surface switch face would serve no function in Jill AND a single surface switch face construction "is simpler than" a two surface switch face.

The Examiner's argument is like arguing that it would be obvious to put a stick shift from a manual transmission on a vehicle having an automatic transmission. In both cases, the modification would serve no previously identified purpose and may indeed impair or destroy the intended functioning of the device which is modified. Once again, absent Applicants' own disclosure, no motivation is disclosed in either Jill or Bob that would lead one of ordinary skill in the art to apply the two surface switch face (108) of Bob to the single point of contact construction of Jill.

(2) The alleged combination would destroy the principle of operation and functioning of both original devices of Jill and Bob.

The rejection is also improper because the alleged combination would destroy the principle of operation and intended functioning of both of the combined references. (See MPEP 2143.05)

Accordingly, the rejection of claim 1 is improper and should be withdrawn. The rejection of claims 2, 5-10, 14-16, 18, 2021, which depend from claim 1, should be withdrawn for at least the same reasons.

In contrast, Bartok requires that its rocking contact 138 (characterized by the Office Action as the switch) be actuated against or engaged at different points of contact to achieve distinct states (electrical contact with terminal 120 or alternatively terminal 122). Contacting rocking contact 138 at the same point of contact will not result in a device being actuated to distinct states. Accordingly, claim 1, as amended, overcomes the rejection based upon Bartok. Claims 2, 5-10 and 18 depend from claim 1 and overcome the rejection for the same reasons.

B. Claim 25

Claim 25, as amended, recites a method for actuating an electronic device between a first state and a second state. The method includes providing a switch configured such that successive actuations of the switch that are identical other than the time at which they are performed in actuate the device between the first state and a second state. The method further includes applying a first manual input so as to actuate the switch a first time and applying a second manual input so as to actuate the switch a second time, wherein the first and second manual inputs are distinct.

Bartok fails to disclose a method wherein distinct manual inputs successfully actuate a switch in identical fashions to actuate a device between the first state and a second state. In rejecting claim 25, the Office Action makes the assertion that successive actuations of a switch that are mirror images of one another are "substantially identical." At the same time, the Office Action allows claim 22 which recites that the successive actuations are "identical." Although

Applicants disagree with the assertion that actuations that mirror one another are somehow "substantially identical." Applicants have amended claim 25 to strike the term "substantially" so as to parallel allowed claim 22. Accordingly, claim 25, as amended, overcomes the rejection based upon Bartok. Claims 28 and 30 depend from claim 25 and overcome the rejection for the same reasons.

III. Rejection of Claims 25-27 and 31 under 35 USC 102(b) Based upon Muz

Section 17 of the Office Action rejected claims 1-8, 18-28, 30 and 31 under 35 USC 102(b) as being anticipated by Muz et al. US Patent 5,610,379. Claims 25-27 and 31, as amended, overcome the rejection.

Claim 25 recites a method for actuating an electronic device. The method includes providing a switch configured such that successive actuations of the switch that are identical other than time at which they are performed to actuate the device between a first state and a second state. The method further includes applying a first input to actuate the switch a first time and applying a second input to actuate the switch a second time, wherein the second input has at least one characteristic, other than the time it which it is performed, that is distinct from the first input.

Muz fails to disclose or suggest an electronic device or a method (1) wherein a switch is configured such that successive actuations of the switch that are identical other than the time which they are performed to actuate the device between a first state and a second state and (2) wherein the switch is successively actuated a first time and a second time using a first input and a second input having at least one distinct characteristic. In contrast, Muz merely discloses two distinct switches: a first switch provided by a first pair of contacts 10, 15 and a second switch provided by a second pair of contacts 10, 15. Nowhere does Muz disclose that successive actuations of the first switch 10, 15 (on the left in Figure 2) actuate the device between two states. Likewise, nowhere does Muz disclose that successive actuations of the second switch (on the right in Figure 2) actuate the device between two states. As apparently acknowledged by the

allowance of claim 22, actuations that mirror another are not identical. Accordingly, claim 25, as amended, overcome the rejection based upon Muz. Claims 26-27 and 31 depend from claim 25 and overcome the rejection for the same reasons.

IV. Rejection of Claims 3, 4 and 19 under 35 USC 103(a) Based upon Bartok and Downing

Section 9 of the Office Action rejected claims 3, 4 and 19 under 35 USC 103(a) as being unpatentable over Bartok US Patent 6,459,060 in view of Downing et al. US Patent 6,075,925. Claims 3, 4 and 19 depend from claim 1 and overcome the rejection for the same reasons discussed above with respect to claim 1. Downing fails to satisfy the deficiencies of Bartok.

V. Rejection of Claims 9-13 under 35 USC 103(a) Based upon Bartok and Parks

Section 10 of the Office Action rejected claims 9-13 under 35 USC 103(a) as being unpatentable over Bartok US Patent 6,459,060 in view of Parks et al. US Patent 5,877,746. Claims 9-13 depend from claim 1 and overcome the rejection for the same reasons discussed above with respect to claim 1. Parks fails to satisfy the deficiencies of Bartok.

VI. Rejection of Claims 14-16 and 20 under 35 USC 103(a) Based upon Bartok and Bob

Section 11 of the Office Action rejected claims 14-16 and 20 under 35 USC 103(a) as being unpatentable over Bartok US Patent 6,459,060 in view of Bob et al. US Patent 5,558,211. Claims 14-16 and 20 depend from claim 1 and overcome the rejection for the same reasons discussed above with respect to claim 1. Bob fails to satisfy the deficiencies of Bartok.

Claim 14 reflect additional features which further patently distinguish claim 14 over the prior art of record including Bartok in view of Bob. Claim 14 recites an expansion coupled to a first button and a second button that is linearly movable relative to the switch.

Neither Bartok nor Bob disclose an extension coupled to a first button and a second button which is linearly movable relative to the switch. In rejecting claim 14, the Office Action acknowledges that Bartok failed to disclose such an extension. As a result, the Office Action attempt to additionally rely upon Bob and characterizes arm 26 as the extension. However, arm 26 of Bob does not linearly move relative to a switch. At most, arm 26 pivots. Accordingly, claim 14, as amended, overcomes the rejection based upon Bartok and Bob for this additional reason.

VII. Rejection of claims 32-34, 36 and 38 under 35 USC 103(a) Based upon Bartok and Mori

Section 12 of the Office Action rejected claims 32-34, 36 and 38 under 35 USC 103(a) as being unpatentable over Bartok US Patent 6,459,060 in view of Mori et al. US Patent 6,337,961. Claims 32-34, 36 and 38, as amended, overcome the rejection.

Claim 32, as amended, recites a switch configured such that successive actuations of the switch actuates an image forming engine between a first state and a second state, a first movable input surface and a second movable input surface. The first movable input surface and the second movable input surface are both rigidly coupled to a post such that movement of the first movable input surface linearly moves the post along an axis against the switch to actuate the engine to the first state and such that movement of the second movable input surface linearly moves the post along the axis against the switch to actuate the engine to a second state.

Neither Bartok nor Mori, alone or in combination, disclose or suggest first and second movable input surfaces that are both coupled to a post such that movement of the first movable input surface linearly moves the post along an axis against the switch to actuate the engine to the first state and such that movement of the second movable input surface linearly moves the post along the axis against the switch to actuate the engine to a second state. Claims 33-34, 36 and 38 depend from claim 32 and overcome the rejection for the same reasons.

VIII. Rejection of Claims 39 under 35 USC 103(a) Based upon Bartok, Mori and Parks

Section 12 of the Office Action rejected claim 39 under 35 USC 103(a) as being unpatentable over Bartok US Patent 6,459,060 in view of Mori et al. US Patent 6,337,961 and further in view of Parks et al. US Patent 5,877,746. Claim 39 depends from claim 32 and overcomes the rejection for the same reasons discussed above with respect to the rejection of claim 32 based upon Bartok and Mori. Parks fails to satisfy the deficiencies of Bartok and Mori.

IX. Added Claim

With this response, claim 41 is added. Section 15 of the Office Action indicated that claim 17 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. In response, claim 17 is rewritten as added claim 41 and includes all of the limitations of former base claim 1. Thus, claim 41 is presented for consideration and allowance.

X. Conclusion

After amending the claims as set forth above, claims 1-36 and 38-41 are now pending in this application.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit

Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

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